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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,709	07/28/2003	Atsushi Kono	MAT-8450US	6708

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EXAMINER
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VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/628,709

Applicant(s)

KONO ET AL.

Examiner

Anatoly Vortman

Art Unit

2835

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.



Anatoly Vortman  
Primary Examiner  
Art Unit: 2835

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive:

In response to applicant's argument that "Sugawara is not analogous art", it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In the instant case it was clearly and explicitly pointed out in the outstanding rejection, that "inventions of AAPA and of Sugawara are from the same field of endeavor (tin covered electrical connectors and devices employing thereof)".

Further, Applicant went on by declaring that tin covered electrical connectors and devices employing thereof are not a field of endeavor and presented a lengthy discussion regarding the different uses of the invention of the instant application and of Sugawara. The Applicant's reasoning is not persuasive, since different use is not a characteristic of the different field of endeavor. Both invention teach tin covered electrical connectors. How this is not the same field of endeavor? Regarding the different use, the Examiner would like to reiterate that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem (i.e. for different use). It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). Although *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done" (emphasis added), reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement for the prior art to provide the same reason as the Applicant to make the claimed invention.

Further, the Applicant went on by declaring that connectors of Sugawara are not tin covered, because the end product is covered with Cu-Sn layer and not with Sn layer. To the contrary, the Examiner would like to reiterate that Sugawara refers to the surface layer as an Sn-coating throughout the disclosure (see, for example, column 2, lines 4-8, 39-41, 47-49, and 58-59; column 5, lines 52-67; column 6, lines 1+, etc). Sugawara refers to the surface layer as an Sn coating, not Cu coating or any another coating. This implies that Sn is a main substance of the surface layer. Had Cu was the main substance, than the surface layer was referred to as Cu coating. This alone would have provided a motivation to an artisan in the fuse art at the time of the invention was made to use the Sn coating (in which Sn is a main substance) for the device of AAPA for improving workability and corrosion resistance of the device. However, in addition, Sugawara clearly and explicitly teaches that Sn is a "main substance" of the surface layer (i.e. more than 50%) (see column 6, lines 7-8).

Further, the Examiner would like to direct the Applicant's attention to the fact, that the end product of Sugawara was used for combination, not the intermediate one as alleged by Applicant, and the end product has improved workability and resistance to corrosion.

Further, regarding the "routine experimentation". The Applicant contends that it was not a routine experimentation to arrive to the disclosed ranges for the ingredients of the alloys comprising the surface layers. This is also not persuasive. If Applicant desires to prove that the experimentation was not a routine one, than the unexpected result(s) over the claimed range(s) should be established by comparing a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range see *In re Hill*, 128 USPQ 197 (CCPA 1960). The disclosure of the instant application has failed to do so.

Further, the Applicant's arguments regarding the method claims are also not persuasive. The so-called "method" claims of the instant application do not recite any particular method or process, but merely restate the structure presented in the apparatus claims. So if apparatus claims have been rejected than the method claims should also be rejected as inherently necessitated by the structure.

In view of the above, the rejection of the claims appears to be proper and is maintained herein.

Anatoly Vortman  
Primary Examiner  
Art Unit: 2835

